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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,002	08/16/2005	Richard Wade	2859-1-001PCT/US	9394
23565	7590	04/19/2007	EXAMINER	
KLAUBER & JACKSON 411 HACKENSACK AVENUE HACKENSACK, NJ 07601			MAZUMDAR, SONYA	
			ART UNIT	PAPER NUMBER
			1734	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/19/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	10/520,002	WADE, RICHARD
	Examiner Sonya Mazumdar	Art Unit 1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 December 2004 and 17 February 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) 1 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 December 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/17/2005</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities:

In line 7, "rhe" should be changed to "the".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "the printing" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 3, and 8 are rejected under 35 U.S.C. 102(b) as being unpatentable by Schumann et al. (WO 00/30963).

With respect to claim 1, Schumann et al. teach a method of applying adhesive labels to products (abstract). Labels (202) are spaced out on a single web (201) where

the label contours (203) are defined in a web by lines of cutting and holding points (205). To remove the labels, the web is passed around a guide (204), causing labels to break off from their holding points to separate from the web and protrusion of the labels' leading edges out of the web (Figure 2). Furthermore, claim 1 discloses using an applicator of "the same function and operation as the conventional beak of conventional application machinery" (lines 5 and 6). Thus it is inherent that the adhesive surface of the labels contacts and adheres to the product, such that the relative movement causes the release of the labels from the web and the remainder material comprises only that of the single web (column 1, lines 4-8; column 3, lines 34-56).

With respect to claim 2, Schumann et al. teach leading edges of labels to be sufficiently devoid of holding points (205) to ensure that it will reliably protrude from the web (201) when it passes around the guide (204) (column 4, lines 56-58; Figure 2).

With respect to claims 3 and 8, Schumann et al. teach applying labels which self-adhesive (column 1, lines 54-56; column 6, lines 26-27).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 1734

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 5, 10, 11, and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Schumann et al. as applied to claims 1 and 2 above, and further in view of Jeffries (US 3,880,692).

The teachings of claims 1 and 2 are as described above.

Although Schumann et al. teach labels to have an adhesive surface (column 1, lines 54-56), there is no specific teaching of applying adhesive to labels on a single-layer web. However, Jeffries teach applying adhesive to a single layer-web of labels, in which the labels are further detached from the web (column 6, lines 6-52; Figures 5, 6, and 7). Thus, it would have been obvious to apply adhesive to labels before being detached from a web to prevent adhesive accumulation in the apparatus (abstract).

8. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumann et al. as applied to claims 1 and 2 above, and further in view of West et al. (US 5,275,678)

The teachings of claims 1 and 2 are as described above.

Schumann et al. do not teach a water application station to wet adhesive on a label prior to application product containers. However, West et al. teach applying water via a water application means (17) to labels (15) with adhesive glue strips (20) prior to applying the labels onto containers (18) (column 5, lines 66 – column 6, line 5; Figures 1 and 2). It would have been obvious to apply water onto an adhesive portion of the label as West et al. taught and would have been motivated to do so to prevent adhesive

accumulation in an apparatus and residue on a container's surface (column 4, lines 51-60).

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schumann et al. as applied to claim 1 above, and further in view of Osaka (US 6,030,482).

The teachings of claim 1 are as described above.

Schumann et al. do not teach providing labels with silicon applied to a first surface of a label to act as a release material. However, Osaka teaches it would have been obvious to one having ordinary skill in the art to apply a silicone release agent over printing on a label, in a case where the label web is rolled up and surfaces do not stick to each other (column 2, lines 33-38; column 10, lines 43-47).

10. Claims 7, 13, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumann et al. in view Osaka.

Schumann et al. teach self-adhesive labels on a web to be applied to products (abstract). Labels (202) are spaced out on a single web (201) where the label contours (203) are defined in a web by lines of cutting and holding points (205) (Figure 2).

Schumann et al. do not teach providing labels with silicon applied to a first surface of a label to act as a release material. However, Osaka teaches it would have been obvious to one having ordinary skill in the art to apply a silicone release agent over printing on a label, in a case where the label web is rolled up and surfaces do not stick to each other (column 2, lines 33-38; column 10, lines 43-47).

"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-

by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonya Mazumdar whose telephone number is (571) 272-6019. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Sonya Mazumdar
SM


Chris Fiorilla
SUPERVISORY PATENT EXAMINER
